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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
PEREZ, ANGELICA	
ART UNIT	**PAPER NUMBER**
2684	

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/882,963	SMITH, BRYAN	
	Examiner	Art Unit	
	Angelica M. Perez	2684	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *06-3-2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-28* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-28* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments, see pages 5-6 of amendment filed 6-3-2004, with respect to the rejection(s)of claim(s) 1-28 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of new art.

Specification

2. The abstract of the disclosure is objected to because it is too long (more than 250 words), it should be no more than 150 words long. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000.

Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1-2, 6-7, 11, 15-16, 23 and 28 are rejected under 35 U.S.C. 102(e) as being anticipated by Petrakos (Petrakos et al.; US 6,731,935 B2)

Regarding claims 1 and 15, Petrakos teaches of an apparatus (Figure 1, items 1-4), and method of alerting a user of a mobile telephone that the user is connected to a second network other than a usual first network (column 1, lines 42-47 and column 3, lines 60 and 61; where the "roaming dial tone" corresponds to alerting the user of a "second network"), comprising: allocating a first set of specific user-definable non-text settings in the user's telephone to a situation where the user is connected to a first network (column 1, lines 42-46; where the "first audible tone" corresponds to that of a "first network" e.g., "home network". Also, "audible tones" correspond to "non-text settings"); allocating a second set of specific user-definable non-text settings in the user's telephone to a situation where the user is connected to a second network (column 1, lines 46-47; where "second audible tone" corresponds to a "second network"; e.g., "roaming"); switching the settings automatically to the first set when user's telephone becomes connected to the first network (column 3, lines 27-34; where when located in the "home network" the "first dial tone" is automatically produced) of the network is switching the settings automatically to the second set when the telephone becomes connected to the second network (column 3, lines 39-44; when the user is "roaming", in the "second network", a "second tone" is automatically set) and circuitry for switching automatically to the first set when user's mobile telephone is connected to the

first network (column 4, lines 35-40, figures 3 and 4, items 18 and 44, respectively; where the "dial tone generator" makes the decision according to the network type; e.g., "home provider" corresponding to "first network"), and for switching automatically to the second set when user's mobile telephone is connected to the second network (column 4, lines 35-40, figures 3 and 4, items 18 and 44, respectively; where the "dial tone generator" makes the decision according to the network type; e.g., "roaming provider" corresponding to a "second network"); and alerting the user immediately before a call is activated, by an indication caused by the first and second non-text settings respectively that the user is connected to the first or second network (column 3, lines 57-65; e.g., ""attempt to originate a call" corresponding to "before a call is activated").

Regarding claims 2 and 16, Petrakos teaches all the limitations of claims 1 and 15, respectively. Petrakos further teaches where the non-text settings in the user's telephone may be selected from indications including: sound; acoustic sounds; LED; vibration; and ring signal (column 1, lines 40-47; where the examiner as selected "acoustic sounds" from the choices provided).

Regarding claims 6, 23, Petrakos teaches all the limitations of claims 1 and 15, respectively. Petrakos also teaches where the first network may be the user's home network/a preferred network (column 3, lines 27-34; where when located in the "home network" the "first dial tone" is automatically produced).

Regarding claims 7, Petrakos teaches all the limitations of claims 6. Petrakos further teaches where the second network may be a foreign network other than the user's home network /preferred network (column 1, lines 46-47; where "second audible

tone" corresponds to a "second network"; e.g., while "roaming" the user may be in a foreign network other than the home network).

Regarding claims 11 and 28, Petrakos teaches all the limitations of claim 1 and 15. In addition, Petrakos teaches where the non-text settings are associated with user defined profiles in the mobile telephone (column 3, lines 50-65; where the tones can be customized according to a user profile).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 5, 9-10, 18, 22 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Petrakos in view of Wakimoto (Wakimoto et al., JP 405268650 A).

Regarding claims 5, 18 and 22, Petrakos teaches all the limitations of claims 2, 15 and 16, respectively.

Petrakos does not specifically teach where an incoming call is associated with a ring signal, the method including the step of the user selecting if the ring signal should be associated with a first or second network.

In related art concerning an incoming call connection control, Petrakos teaches where an incoming call is associated with a ring signal, the method including the step of the user selecting if the ring signal should be associated with a first or second network

(page 2, lines 5-12; where "domestic information" corresponds to a "first network" and "international information" corresponds to a "second network").

It would have been obvious to a one of ordinary skill in the art at the time the invention was made to combine Petrakos's method and apparatus for generating information-bearing audible tones with Wakimoto's ringer in order to provide an alternative indicator to the method and allowing the user to selectively manage calls, as taught by Wakimoto.

Regarding claims 9 Petrakos in view of Wakimoto teaches all the limitations of claim 8. Petrakos also teaches where the first network may be the user's home network /a preferred network (column 3, lines 27-34; where when located in the "home network" the "first dial tone" is automatically produced).

Regarding claims 10 and 24, Petrakos in view of Wakimoto teaches all the limitations of claims 8 and 23, respectively. Petrakos further teaches where the second network may be a foreign network other than the user's home network /preferred network (column 1, lines 46-47; where "second audible tone" corresponds to a "second network"; e.g., while "roaming" the user may be in a foreign network other than the home network).

7. Claims 8, 12 and 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Petrakos in view of Linkola (Linkola, Janne; US Patent No.: US 6,516,190 B1).

Regarding claims 8, 12 and 25, Petrakos teaches all the limitations of claims 1 and 15. Petrakos further teaches where the user's telephone includes a display (figure 1, item 2).

Petrakos does not specifically teaches where the display can show an identification of a current connected network which may be confirmed by the user reading text on the display.

In related art concerning a method and apparatus for calculating charge rates in a mobile communication system, Linkola teaches where the display can show an identification of a current connected network which may be confirmed by the user reading text on the display (columns 9; lines 38-59; e.g., "...mobile network code...).

It would have been obvious to a one of ordinary skill in the art at the time the invention was made to combine Petrakos's method and apparatus for generating information-bearing audible tones with Linkola's mobile network code, in order to provide location information that indicates the identity of the network, as taught by Linkola.

Regarding claims 26 and 27, Petrakos in view of Linkola teaches all the limitations of claim 25. Petrakos further teaches where the second network may be a foreign network other than the user's home network /preferred network (column 1, lines 46-47; where "second audible tone" corresponds to a "second network"; e.g., while "roaming" the user may be in a foreign network other than the home network).

8. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Petrakos in view of Thompson (Thompson, Robin Jeffrey; US Patent No.: US 5,999,521 A).

Regarding claims 14, Petrakos teaches all the limitations of claims 1.

Petrakos does not specifically teach of including voice dialing and activating, connected with an outgoing call.

In related art concerning a system and method for providing local services to wireless telephones served by other systems, regarding a device control apparatus, Thompson teaches of including voice dialing and activating, connected with an outgoing call (column 1, lines 42-53; where the voice dialing activates the call).

It would have been obvious to a one of ordinary skill in the art at the time the invention was made to combine Petrakos's alerting method with Thompson's voice dialing in order to provide the user with a personalized manner of handling calls by providing voice dialing, as taught by Thompson.

9. Claims 3, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Petrakos in view of Wakimoto as applied to claims 2 and 16 above, and further in view of Thompson (Thompson, Robin Jeffrey; US Patent No.: US 5,999,521 A).

Regarding claims 3 and 20, Petrakos in view of Wakimoto teaches all the limitations of claims 2 and 16, respectively.

Petrakos in view of Wakimoto does not specifically teach where the acoustic sounds are associated with a prompt used during voice dialing.

In related art concerning a system and method for providing local services to wireless telephones served by other systems, regarding a device control apparatus, Thompson teaches of the acoustic sounds are associated with a prompt used during voice dialing (column 1, lines 42-53; where the voice dialing indicates a call initiation).

It would have been obvious to a one of ordinary skill in the art at the time the invention was made to combine Petrakos's and Wakimoto's alerting method with Thompson's voice dialing in order to provide the user with a personalized manner of handling calls by providing voice dialing, as taught by Thompson.

10. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Petrakos in view of Linkola as applied to claim 12 above, and further in view of Takahara (Takahara, Yasuaki; US Patent No.: US 5,450,613 A).

Regarding claim 13, Petrakos in view of Linkola teaches all the limitations according to claims 12.

Petrakos in view of Linkola does not specifically teach where the graphic display comprises an LCD display.

In related art regarding a mobile communication device with out of range notification, Takahara teaches where the graphic display comprises an LCD display (column 1, lines 36-48; where the examiner selected LED from the choices provided by the applicant).

It would have been obvious to a one of ordinary skill in the art at the time the invention was made to combine Petrakos's in view of Linkola's graphic display method

with Takahara's LCD display in order to provide graphical of whether or not the user is within the service area, as taught by Takahara.

11. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Petrakos in view of Takahara.

Regarding claim 19, Petrakos teaches all the limitations according to claims 15.

Petrakos does not specifically teach where the graphic display comprises a display chosen from LCD display and an LED display.

In related art regarding a mobile communication device with out of range notification, Takahara teaches where the graphic display comprises an LCD display (column 11, lines 50; where the examiner selected LED from the choices provided by the applicant).

It would have been obvious to a one of ordinary skill in the art at the time the invention was made to combine Petrakos's graphic display method with Takahara's LCD display in order to provide graphical of whether or not the user is within the service area, as taught by Takahara.

12. Claims 4, 17 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Petrakos in view of Kahata (Kahata, Ryoichi; JP Patent No.: 411,177,725 A).

Regarding claims 4, 17 and 21 Petrakos teaches all the limitations of claims 2, 15 and 16, respectively.

Petrakos does not specifically teach where the vibration setting is used in association with one or more of voice dialing, flip opening or key pressing.

In related art concerning a charge notice system for portable telephone sets, Kahata teaches where the vibration setting is used in association with one or more of voice dialing, flip opening or key pressing (page 2, lines 9-21).

It would have been obvious to a one of ordinary skill in the art at the time the invention was made to combine Petrakos's method and apparatus for generating information-bearing audible tones with' Kahata's vibration setting used in association with voice dialing in order to indicate added charges during a telephone call, as taught by Kahata.

Conclusion

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Angelica Perez whose telephone number is 703-305-8724. The examiner can normally be reached on 7:15 a.m. - 3:55 p.m., Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nay Maung can be reached on 703-308-7745. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and for After Final communications.

Information regarding Patent Application Information Retrieval (PAIR) system can be found at 866-217-9197 (toll-free).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 2600's customer service number is 703-306-0377.

Angelica Perez
(Examiner)

NAY MAUNG
SUPERVISORY PATENT EXAMINER

Art Unit 2684

July 28, 2004